

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/676,211

Applicant: Chesley P. Dillon

Filed: October 1, 2003

TC/AU: 2617 (Confirmation No. 9698)

Examiner: CAI, WAYNE HUU

Docket No.: 252040 (Client Reference No. GP-303949)

Customer No.: 23460


REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer to Appellants' Brief on Appeal, Appellants now submit their Reply. This Reply will address primarily the Examiner's Response to Argument (§10).

Claims 1-20 and 22-24 are currently pending and stand rejected as obvious in view of Webb (and other references for certain claims). The claimed subject matter pertains generally to a telematics subscriber event notification system that is different in a number of respects from that taught in Webb. However, for purposes of Appeal, the disagreement comes down to a single issue: the claimed system sends a notification message to the telematics unit, wherein the notification message initiates two distinct occurrences: (1) it causes the user to be notified of the event, and (2) it causes an action to be automatically executed.¹

<i>MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10</i>			
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<i>Name (Print/Type)</i>	Phillip M. Pippenger, reg. 46,055		
<i>Signature</i>		<i>Date</i>	December 5, 2007

¹ See independent claims 1, 8, 14, and 22.

The allegedly analogous “notification” of Webb does not meet these criteria. In particular, the notification of Webb does not cause an action to be automatically executed; it just notifies. In the Answer, the Examiner admits that the previously cited query of Webb is not a suitable action since it is not caused by the notification. In order to salvage the rejections, the Examiner has attempted to find another “action” in Webb that is a result of the notification. In particular, the Examiner’s “Response to Arguments” indicates that the notification of Webb causes a pop-up window to appear, and now the display of a pop-up window is said to be the required “action.”

If, as the Examiner asserts, Webb’s creation of a pop-up window is the “action” required by the pending claims, then this case is ripe for reversal for several reasons:

- (1) The recited notification message is two pronged -- it causes the user to be notified of the event, and it causes an action to be automatically executed. Clearly these are two separate occurrences. It defies logic to assert that Webb’s pop-up window is a notification to the user but that *act* of notifying is itself the recited “action.”² Webb’s pop-up window is either the action or a means of notifying the user, not both. And at page 4 of the Examiner’s Answer, the Examiner has already told us that the pop-up window fulfills the element of a notification. It cannot then be double-counted as the recited “action.”
- (2) The claims don’t call for just any random action to be performed pursuant to the notification message. For example, see pending claim 1. It expressly recites that the automatic action is one that is *associated with an event from the earlier recited event activation table*. Webb’s action of displaying a pop-up window is not an event (Birthday, Anniversary, etc.) that would be listed in an event activation table. There obviously is no

² The Examiner asserts that the Webb user sees both an email and a pop-up. This apparently stems from a linguistic misunderstanding. Webb teaches at paragraph 33 that the notification is “either” of an email and a pop-up. There are not two separate notifications, and the remainder of paragraph 33 makes clear that there is one notification, and this one notification contains certain information. At one point Webb uses the phrase “and/or” between “email” and “pop-up,” but the same sentence uses the limitation “either,” clearly indicating that the notification is *either* an email or a pop-up, not both.

event listing, event table, or other event tracking system in Webb wherein one of the events is "make a pop-up window."

- (3) The claims require that the subscriber notification transmission must include an indication of the action to be performed. There is no reason to think that the subscriber notification of Webb includes mention of a pop-up window being displayed. This is to be expected, since the "action" of displaying a pop-up window would more likely be associated with a local application or operating system.

Although the foregoing remarks were expressly related to claim 1, it will be appreciated that some or all of the discussed limitations are included the other independent claims as well. Thus, Webb fails to teach a limitation of each independent claim, and cannot render any pending claim unpatentable. Consistent with the prosecution to date, the remaining references do not cure these deficiencies. It is respectfully requested that the rejections be reversed and the case returned to the Examiner for further consideration.

Respectfully submitted,



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